

## **REMARKS**

### **1. Supplemental Amendment**

This supplemental amendment is provided to amend claim 32. The substance of the Amendment is substantially similar to that filed on July 30, 2009, and thus can be used as a replacement for the Amendment of July 30, 2009. Applicants request entry of this Supplemental Amendment.

### **2. Amendments to the Claims**

Claim 19 is amended to recite a "patient". Support for this amendment is found in the Specification at page 105, line 22.

Claim 32 is amended. Support for the amendment to claim 32 can be found in the Specification at page 101, lines 13-20, Example 5, and on page 105, line 22.

New claims 33-35 have been added. Support for claims 33 and 34 is found in the Specification at page 60, lines 7-10 and at page 58, lines 10-13 respectively. Support for claim 35 is found in the Specification at pages 92-102, especially, page 101, lines 4-12.

No new matter has been added.

### **3. Rejections under 35 U.S.C. § 102(b)**

#### **a. U.S. Patent 6,423,501 and WO 98/25647**

The Examiner rejects claims 19-20, and 32 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,423,501 (hereinafter '501). The Examiner also rejects claims 19-20, and 32 under 35 U.S.C. § 102(b) as being anticipated by WO 98/25647 (hereinafter '647). Applicants respectfully disagree.

As discussed in the last response, '501 and '647 fail to teach a method of treating IBD with anti-CD-81 antibodies.

The Examiner states that “the mechanism of action does not have a bearing on the patentability of the invention if the invention was already known or obvious.” (Office Action, page 4). ‘501 does not disclose the shortening of the intestinal length associated with IBD or the loose stool or diarrhea associated with IBD. An antibody to a single B cell surface marker out of a laundry list of B cell surface markers when administered to a subset of patients from a laundry

list of possible patients does not put the public in possession of a specific treatment for a specific disease in any meaningful way. That said treatment would also have specifically claimed results is also not disclosed in any meaningful way.

The Examiner discounts the fact that there was no satisfactory treatment for IBD at the filing date. The Examiner states that “evidence of secondary considerations . . . is irrelevant to 35 U.S.C. § 102.” (Office Action, page 5). Applicants submit that this is not evidence of secondary considerations, but is instead evidence that the public was not in possession of the claimed invention prior to the filing of the present application. Essentially, these references illustrate that one of skill in the art would not have combined the publication’s description of the invention with his own knowledge to obtain the present invention. As the Examiner is allowed to use a secondary reference to prove that the primary reference contains an enabled disclosure (In re Donohue, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985); cited in MPEP § 2131.01), Applicants should be allowed to provide a reference to show that the primary reference does not contain an enabled disclosure.

Accordingly, Applicants submit that ‘501 and ‘647 do not contain enabling disclosures for the claimed method. Applicants therefore request that the rejection be withdrawn.

**b. WO 00/67796**

The Examiner rejects claims 19-20, and 31-32 under 35 U.S.C. § 102(b) as being anticipated by Curd et al. (WO 00/67796)(hereinafter Curd). Like ‘501 and ‘647 above, Curd does not provide any examples of treating IBD, does not provide any specific antibodies, and does not in any way put the public in possession of the claimed method in such a manner that one of skill would be able to obtain the present invention from this reference.

Accordingly, Applicants request that the rejection be withdrawn.

**4. Rejections under 35 U.S.C. § 103**

The Examiner rejects claim 31 under 35 U.S.C. § 103 as unpatentable over '501 or '647 further in view of Owens et al. (1994)(hereinafter Owens). As discussed above, neither '501 or '647 contains an enabling disclosure. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mark J. Nuell Reg. No. 36,623 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: August 20, 2009

Respectfully submitted,

By 

Mark J. Nuell

Registration No.: 36,623

BIRCH, STEWART, KOLASCH & BIRCH, LLP

12770 High Bluff Drive, Suite 260

San Diego, California 92130

(858) 792-8855

Attorney for Applicant